

Applicant : Lee et al.
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Attorney's Docket No.: 09595-004002

REMARKS

Claims 2-31 were pending. Claims 2-4, 9, 10, 11, 16, 17, 18, 23, 26, 27, 28, and 30 are independent claims. Claims 2-22 stand rejected under 35 U.S.C. Section 101 as claiming the same invention as that of claims 1-21 of commonly owned U.S. Patent No. 6,163,859 ("the '859 patent"). Claims 23-29 stand rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 5,202,982 to Gramlich et al. ("Gramlich"). Claims 30 and 31 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Gramlich in view of U.S. Patent No. 5,008,853 to Bly ("Bly").

SECTION 101 REJECTIONS

Claims 2-22 stand rejected under 35 U.S.C. Section 101 as claiming the same invention as that of claims 1-21 of the '859 patent. The applicant has amended claims 2-22 and respectfully submits that, as amended, these claims are no longer coextensive in scope with claims 1-21 of the '859 patent. Statutory double patenting does not exist if there is an embodiment that falls within the scope of one claim but not the other. See M.P.E.P. Section 804.II.A, at p. 800-20. The applicant respectfully submits that such is the case here. Claims 1-21 of the '859 patent each require, for example, that instances of the software components stored on the software vault be unique. None of claims 2-22 of the instant application has this requirement. Accordingly, a software vault that includes non-unique software components would not infringe claims 1-21 of the '859 patent but may infringe claims 2-22 of the instant application. Thus, there is no double patenting with respect to claims 2-22 of the instant application and claims 1-21 of the '859 patent.

SECTION 102 REJECTIONS

Claim 23 stands rejected as being anticipated by Gramlich. The applicant has amended claim 23 and respectfully submits that Gramlich does not disclose or suggest limitations of claim 23. For example, claim 23 now recites:

"analyzing run-time states of an application that includes one or more components and generating, for each component of the application and based on a

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result of analyzing run-time states, current metadata that describes the component, the analyzing and generating being performed by a client computer, and the components being stored on one or more software vaults associated with and remote from the client computer;

creating a first key for each of the one or more components of the application, each first key of a component being created from and unique to the current metadata that describes the component.”

The applicant respectfully submits that Gramlich does not disclose or suggest the analyzing and creating steps. In particular, Gramlich does not teach analyzing run-time states of an application and generating, for each component of the application and based on a result of analyzing run-time states, metadata that describes the component, as required by claim 23. Moreover, Gramlich does not teach creating a key from metadata generated based on analyzing run-time states of an application, as also required by claim 23. Gramlich discloses generating a name for a database component file from the content and file name of a source file. *See* Gramlich, at col. 6, l. 29-31. The Examiner contends that the name can constitute the claimed key and the content and file name can constitute metadata generated based on analyzing run-time states of an application. The applicant must disagree. As Gramlich does not teach analyzing run-time states of an application, Gramlich cannot teach creating a key from metadata generated based on such an analysis. For at least the above reasons, claim 23 and claims 24 and 25, which depend from claim 23, are in condition for allowance.

Claims 26-29 each includes limitations similar to those discussed above with respect to claim 23. For at least reasons similar to those discussed above, the applicant respectfully submits that claims 26-29 are in condition for allowance.

SECTION 103 REJECTIONS

Claims 30 and 31 stand rejected as being unpatentable over Gramlich in view of Bly. Claims 30 and 31 each includes limitations similar to the above-cited limitations of claim 23. As discussed above, Gramlich does not disclose or suggest these limitations. The Examiner does

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not contend that Bly discloses or suggests these limitations, and the applicant submits that Bly in fact fails to do so. For at least these reasons, claims 30 and 31 are in condition for allowance.

NEW CLAIMS

The applicant respectfully submits new claims 32 and 33. Claim 32 recites a computer program product for analyzing run-time states of an application, generating keys for components of the application, and comparing keys generated. Claim 33 recites a computer program product for performing the method of claim 23. Claims 32 and 33 include limitations similar to those discussed above. For reasons similar to those discussed above, claims 32 and 33 are in condition for allowance.

Please apply \$212 for excess claim fees and \$110 for a one-month extension of time, and any other appropriate charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

October 12, 2004
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